

ESTTA Tracking number: **ESTTA128142**

Filing date: **03/05/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91162370
Party	Defendant De Beers LV Ltd De Beers LV Ltd 1 Silk Street GBX London, EC2Y 8HQ
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Date	03/05/2007
Attachments	NY- #511919-v1-De_Boulle_v_De_Beers__Resp_to_Opp_Motiion_to_Compel.pdf ( 5 pages )(144282 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

*Atty. Ref.: 0820278.0103*

De Boulle Diamond & Jewelry, Inc.	:	
	:	
Opposer,	:	Consolidated Opposition No.: 91162370
	:	Opposition Nos. 91162370
-against-	:	91162469
	:	91164615
De Beers LV Ltd.	:	91165285
	:	91165465
Applicant.	:	

**APPLICANT'S RESPONSE TO  
OPPOSER'S MOTION TO COMPEL RESPONSES TO DISCOVERY**

Applicant, De Beers LV Ltd. ("De Beers") by its undersigned attorneys, hereby submits this Response to De Boulle Diamond & Jewelry, Inc.'s (hereinafter "Opposer") Motion to Compel Responses to Discovery (hereinafter "Motion") and requests an order denying Opposer's Motion.

**PRELIMINARY STATEMENT**

Opposer's Motion to Compel Responses to Discovery should be denied because it was not filed within the statutorily prescribed period and is therefore procedurally defective. If Opposer believed that De Beer's discovery responses were inadequate, it was required to file a motion to test the sufficiency of De Beer's discovery responses before the first testimony period opened, which was on November 24, 2006. Accordingly, Opposer's Motion is statutorily barred and therefore should be denied.

## **FACTUAL BACKGROUND**

On February 12, 2007, Opposer filed its Motion requesting that the Board now compel De Beers to respond to discovery. De Beers reminds the Board that this Motion has been filed after the discovery and testimony periods have long since expired. The following provides a summary of Opposer's actions to date:

- On September 27, 2004, Opposer filed the first two oppositions against De Beer's marks, Serial No. 78/245,219, "DB LOGO" and Serial No. 78/245,779, DB MONOGRAM.
- On July 20, 2005, the Board consolidated all of Opposer's pending oppositions into the proceeding that is currently before the Board.
- On July 27, 2005, Opposer served its discovery requests on De Beers.
- On October 3, 2005, De Beers answered Opposer's discovery requests.
- On November 18, 2005, De Beers served Opposer with its own discovery requests.
- On April 11, 2006, the Board extended the original discovery period until June 1, 2006 and extended Opposer's 30-day testimony period until August 30, 2006.
- On May 31, 2006, Opposer filed a Motion to Compel Production of Documents due to Opposer's failure to comply with its discovery obligations.
- On June 6, 2006, the Board issued its Order to Compel Documents and reset the discovery period to close on September 25, 2006 and reset Opposer's 30-day testimony period to close no December 24, 2006.
- *On November 24, 2006, Opposer's reset testimony period opened.*
- On January 9, 2007, De Beers filed a motion for discovery sanctions.
- On February 12, 2007, Opposer brought its Motion to Compel Discovery.

## **ARGUMENT**

Trademark Rule 2.120(e) provides in pertinent part that a motion to compel must be filed prior to the commencement of the first testimony period as originally set or as reset. Opposer

failed to file its Motion prior to the commencement of the most recent testimony period (i.e., November 24, 2006). Accordingly, Opposer's present Motion is procedurally defective and barred. *See also*, T.B.M.P §523.03 (a party's "motion should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate *and must, in any event, be filed before the first testimony period opens*") (emphasis added).

### **CONCLUSION**

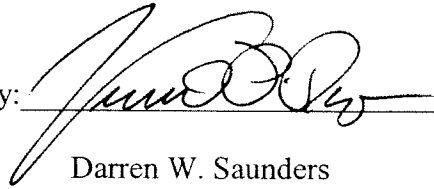
For the foregoing reasons, De Beers respectfully requests that the Board deny Opposer's Motion.

Respectfully submitted,

DE BEERS LV LTD.

Dated: March 5, 2007

By: \_\_\_\_\_

A handwritten signature in black ink, appearing to read "Darren W. Saunders", written over a horizontal line.

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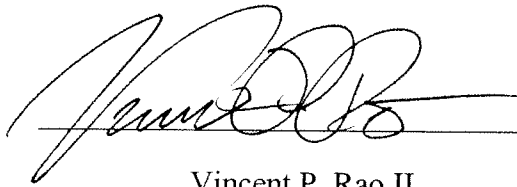
**CERTIFICATE OF SERVICE BY MAIL**

I hereby certify that on the 5th day of March, 2007, I served a true and correct copy of the foregoing Response to Opposer's Motion to Compel Responses to Discovery on the attorneys for the Opposer at the addresses indicated below, by depositing said document in the United States mail, first-class postage prepaid:

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Dated: March 5, 2007



A handwritten signature in black ink, appearing to read 'Vincent P. Rao II', is written over a horizontal line.

Vincent P. Rao II